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IN THE

Supreme Court of the United States

October Term—1948

No. 114

BEST & CO., INC.,

Petitioner,

—against—

SADIE S. MILLER, doing business under the name and style of Miller's Lilliputian Shoppe,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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IN THE

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No. 114

BEST & CO., INC.,

Petitioner,

—against—

SADIE S. MILLER, doing business under the name and style of Miller's Lilliputian Shoppe,

Respondent.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the District Court, per Coxe, *D.J.* (R. 429-434), is reported in 67 F. Supp. 809. The majority opinion of the Circuit Court of Appeals for the Second Circuit, written by Judge Swan and concurred in by Judge Frank (R. 444-450) and the dissenting opinion of Judge Clark (R. 450-455) are reported in 167 F. [2d] 374.

Jurisdiction

Petitioner sued respondent for trademark infringement and unfair competition, jurisdiction of the claim of trademark infringement being conferred upon the federal courts by the Trademark Act of 1905, Sec. 16 (Act of February 20, 1905, c. 592, Sec. 16, 33 Stat. 728; 15 U. S. C., Sec. 96);

and now applies for a writ of certiorari pursuant to the provisions of Section 240 of the Judicial Code, as amended (Act of March 3, 1891, c. 517, Sec. 6, 26 Stat. 828; Act of March 3, 1911, c. 231, Sec. 240, 36 Stat. 1157; Act of February 13, 1925, c. 229, Sec. 1, 43 Stat. 938; U. S. C., Title 328, Sec. 347).

Statement of Case

Petitioner claimed below that its registered trademark "Liliputian Bazaar" has been infringed by the respondent's conduct of her business in Stamford, Connecticut, under the name "Miller's Lilliputian Shoppe", and that she has been guilty of unfair competition in connection therewith. Respondent claims the right to continue to use her tradename, based upon the prior establishment of her business in Stamford, Connecticut and its vicinity, the manner in which she and her predecessor in interest have used the name, and petitioner's laches and acquiescence.

Best & Co., the petitioner, is a large retail specialty shop which has done business in New York City for many years, and has opened branch stores in various cities beginning in 1929 (R. 430).

Respondent is the widow of Jacob Miller who founded the business in 1930, prior to the time when petitioner opened stores outside of the State of New York. She conducts a single small store in Stamford, Connecticut, confining her business to the retail sale of wearing apparel for infants and children. She has employed between three and ten employees and her gross sales have ranged from approximately $46,000 in 1940 to $134,000 in 1944. The business has always been conducted under the name of "Miller's Lilliputian Shoppe" and its advertising has been purely local in nature (R. 431).

In 1933 the existence of Miller's Lilliputian Shoppe was brought to the attention of the petitioner who, then and again in 1934, demanded that plaintiff's husband discontinue the use of the words "Lilliputian Shoppe". This demand was ignored and nothing further was done by the petitioner until 1942, when its president, in selecting a site for petitioner's branch store to be opened there, noticed the defendant's place of business and selected as petitioner's Stamford location a store diagonally across the street from that of the respondent. Petitioner's Stamford branch was opened in August 1942, and in October 1944 another demand was made upon the respondent to discontinue the use of her tradename. Upon her refusal, action was for the first time instituted (R. 432).

After consideration of detailed evidence offered by both parties with respect to the conduct of their respective businesses and the use of their respective tradenames and marks, the District Court found no instance or likelihood of confusion or deception and dismissed the complaint, both as to the cause of action predicated upon alleged infringement and that predicated upon unfair competition. The Circuit Court of Appeals affirmed.

Summary of Argument

The Trial Court properly conceived the question presented as "purely one of fact" (R. 433). District Judge Coxe said that "the test is whether the public is likely to be deceived", and the Circuit Court of Appeals, in affirming, expressly approved the form of the question as framed by the Trial Judge and the test which he applied in its solution (R. 499).

The courts below thus limited their rulings to the facts before them and treated the case as an ordinary one for trademark infringement and unfair competition.

This Court has repeatedly refused to review a determination of infringement or non-infringement, in accordance with its settled practice that certiorari will not issue to review questions of fact.

Upon examination of the decisions cited by the petitioner as the basis for the supposed conflict in the decisions, such conflict appears to be non-existent and may be seen to spring from differences in fact in the various litigations and not from any difference in fundamental principles.

Apart from relying upon an alleged conflict among various decisions cited, petitioner urges that the decision below should be reviewed by this Court "because of the important and unsettled questions of law involved". However, it clearly appears that the courts below applied to the facts of this case, as found by the Trial Court and concurred in by the Circuit Court of Appeals, well settled principles of law; and the questions which petitioner seeks to spell out (Br. p. 28) are, for the most part, hypothetical and abstract questions, which are not raised by the record in this case.

POINT I

The crucial issue in this case is one of fact and turns upon whether or not respondent's use of her tradename is likely to cause confusion or mistake.

The question of whether or not there is an infringement or unfair competition in a given case is purely one of fact, and "judicial interference will depend upon the facts proved and found in each case."

American Foundries v. *Robertson,* 269 U. S. 372, 381.

See also:

Home Scale Co. v. *Wyckoff Seamens & Benedict,* 198 U. S. 118, 137;
Glenmore Distilleries Co. v. *National Distillers,* 101 Fed. [2d] 479; cert. den. 307 U. S. 632;
McLean v. *Fleming,* 96 U. S. 245, 251.

The Trial Court here applied, from the point of view of the petitioner, the broadest possible rule, holding that, for petitioner to succeed, it was only required to prove a likelihood or possibility of confusion, rather than actual confusion. Applying this test, District Judge Coxe, although finding that "Liliputian Bazaar had acquired a secondary meaning applicable to Best & Co.", nevertheless found against the possibility of confusion (R. 433).

The Circuit Court of Appeals expressly affirmed these findings (R. 449).

This Court has time and again held that certiorari will not be granted for the purpose of reviewing factual determinations (*Southern Power Co.* v. *North Carolina Public Service Co.,* 263 U. S. 508, 509; *United States* v. *Johnston,* 268 U. S. 220, 227; *General Talking Pictures Corp.* v. *Western Electric Co.,* 304 U. S. 175, 178); and the rule is, if anything, even stronger in a case where the findings of the Trial Court have been concurred in by the Circuit Court of Appeals. As recently as June 21, 1948, this Court, in the case of *Comstock* v. *Group of International Investors* (October 1947 Term, Docket Nos. 451-454, not yet officially reported), said:

"A seasoned and wise rule of this Court makes concurrent findings of two courts below final here in the absence of very exceptional showing of error. *Stuart*

v. *Hayden*, 169 U. S. 1; *Brainard* v. *Buck*, 184 U. S. 99; *First National Bank* v. *Littlefield*, 226 U. S. 110; *Baker* v. *Schofield*, 243 U. S. 114; *Second Russian Insurance Co.* v. *Miller*, 268 U. S. 552; *Texas & No. O. R. Co.* v. *Brotherhood of Clerks*, 281 U. S. 548; *Page* v. *Arkansas Natural Gas Corp.*, 286 U. S. 269; *Pick* v. *General Motors Corp.*, 299 U. S. 3; *Virginia R. Co.* v. *System Federation*, 300 U. S. 515; *United States* v. *O'Donnell*, 303 U. S. 501; *Anderson* v. *Abbott*, 321 U. S. 349; *Allen* v. *Trust Co.*, 326 U. S. 630; *United States* v. *Dickinson*, 331 U. S. 745. No such error is claimed by petitioner."

An examination of petitioner's contentions here, as well as the dissenting opinion of Circuit Judge Clark on which they are in large measure based, indicates quite clearly that there is no disputed legal principle in question. The asserted conflict arises because neither the Trial Court nor the majority of the Circuit Court of Appeals found in the evidence any possibility or likelihood of deception or confusion, whereas the dissenting judge reviewed the evidence (R. 454) and came to a contrary conclusion upon the facts, upon which his legal conclusions in turn rested.

A mark is infringed only where it is likely to cause confusion or mistake in the minds of the public or to deceive purchasers. As already indicated, this is essentially a question of fact, which can in no way be transformed into a novel question of law. The court below found that the marks in their totality and use were not confusingly similar; and upon such finding, judgment was awarded and affirmed in favor of the respondent.

A similar result was reached in each of the following cases, in each of which this Court denied a writ of certiorari:

Sears, Roebuck & Co. v. *Elliott Varnish Co.*, 232 Fed. 588, cert. den. 242 U. S. 635 ("Never Leak" held not to infringe "Roof Leak");

A. J. Krank Mfg. Co. v. *Pabst*, 277 Fed. 15, cert. den. 259 U. S. 580 ("Twilight Lather Cream" held not to infringe "Krank's Lather Kreem");

T. P. Larson, Jr. Co. v. *Wm. Wrigley, Jr. Co.*, 253 Fed. 914, cert. den. 248 U. S. 580 ("Peptomint" held not to infringe "Spearmint");

Glenmore Distilleries Co. v. *National Distillers*, 101 Fed. (2d) 479, cert. den. 307 U. S. 632 ("Kentucky Tavern" held not infringed by "Town Tavern");

John Mornell & Co. v. *Doyle*, 97 Fed. (2d) 232, cert. den. 305 U. S. 643 ("Strongheart" held not to infringe "Red Heart");

Dixi-Cola Laboratories, Inc. v. *Coca Cola Co.*, 117 Fed. (2d) 352, cert. den. 314 U. S. 629 ("Dixi-Cola" held not to infringe "Coca-Cola").

The petitioner here has received the same protection as the authorities accord to arbitrary, fanciful registered trademarks, though the validity of its trademark was challenged by the respondent and was not passed upon by either of the courts below.

In its petition for certiorari, under the heading "Question Presented" petitioner has posed the single question, "was there infringement of the trademark 'Liliputian Bazaar' * * * or was there unfair competition with plaintiff when defendant entered the same business * * * under the name Miller's Lilliputian Shoppe * * * *" (Petition, p. 7).

Under the well-settled rules and practice of this Court, only those questions which are directly presented in a petition for certiorari (apart from those specified in a supporting brief), may be considered for review. *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 177. Accordingly, the court's consideration of the petition may well stop at this point. Nevertheless, we shall direct ourselves briefly to the other questions argued by the petitioner in its brief.

POINT II

The decision in this case is not in conflict with the cases relied upon and cited by the petitioner.

The petitioner here, in a labored argument which has ignored completely the facts of the several cases and the factual distinctions among them, has urged, as a ground for review by this Court, the usual contention that the decision of the Circuit Court of Appeals in this case is in conflict with other cases cited. We submit that there is no such conflict when each case is considered upon its facts, and when it is remembered that in matters of trademark law precedents are of limited value "because there are few general rules to guide the courts in these cases and because infringement is determined largely by the facts in each case". *Nims, Unfair Competition and Trademarks* (Fourth Edition 1947), at page 670, and cases there cited.

A.

Petitioner leans most heavily upon an asserted direct conflict between the decision in this case and the decision of the same court in *Triangle Publications* v. *Miss Seven-*

teen Foundations, Fed. [2d] , decided shortly after this case. The later decision followed the decision of the Eighth Circuit in *Hanson* v. *Triangle Publications,* 163 Fed. [2d] 74; cert. den. 332 U. S. 855. The petitioner makes much of the fact that the personnel of the bench in the Circuit Court of Appeals in the two cases differed. It is significant to note, however, that two judges sitting in each case were the same,—Judge Clark, who wrote the dissent in the case at bar and Judge Frank who dissented from the later decision. We have already indicated that Judge Clark's disagreement with his colleagues in the instant case turned upon his disagreement with their affirmance of the Trial Court's finding that there was no likelihood of confusion. Likewise, in the *Miss Seventeen* case, Judge Frank himself made it clear that his disagreement with his colleagues was based upon their findings of fact as well as upon the law. At page 1240 of the record on appeal in that case, he said:

> "In affirming the decree, I think my colleagues have made some vital mistakes both as to crucial facts and legal principles."

And again, at page 1243, he stated that in that case he saw no probability of confusion, adding, however, the following:

> "Of course that conclusion would have to yield were there here a finding, supported by evidence, of actual confusion or clear evidence that it is likely."

That there was such a finding and such evidence is clear from the majority opinion, written by Circuit Judge A. N. Hand.

In the face of such findings, none of which were made by either of the courts below in the case at bar, judgment for the plaintiff followed as of course.

B.

In urging that the decision below is in conflict with the Ninth Circuit's recent decision in *Stork Restaurant, Inc.* v. *Sahati,* 166 Fed. [2d] 348, and cases therein cited, petitioner has read into the decision of the Circuit Court of Appeals in the instant case a holding which cannot be found there. Petitioner, at page 17, argues:

> "The majority of the Court in this case distinguished between trade names and trade-marks and, in effect, held that where the marks do not denote products, and there is not proof of deception or actual confusion, the fact that one merchant has appropriated the trade name of another is not sufficient to warrant granting relief to the prior user."

We have searched the opinions below in vain for any basis for petitioner's argument. Far from distinguishing between trademarks and tradenames, the Circuit Court of Appeals in this case used the terms indiscriminately (R. 446, 448-449).

C.

Likewise, petitioner's argument that the decision below conflicts with the decision of this Court in the case of *Menendez* v. *Holt,* 128 U. S. 514, and other cases referred to in Point III of the petitioner's brief, is based upon a mis-reading of the decisions below and mis-construction of the facts of the case at bar.

It must be borne in mind, in examining the record in this case (because petitioner's brief lays great stress upon the respondent's use of the single word "Lilliputian" as part of her tradename), that petitioner's mark is "Liliputian Bazaar". The evidence established that petitioner has never, at any time, used the word "Liliputian" alone in any respect; it has always been used as part of petitioner's entire mark, "Liliputian Bazaar"; and it is the phrase "Liliputian Bazaar" which the courts below found had acquired a secondary meaning pointing to Best & Co.

Petitioner cannot cite a single case to support the assertion that the development of a secondary meaning in a multiple or compound word-mark endows the owner with exclusive rights in each of its compound parts.

It is obvious from the many other businesses in which that name is used and the many other persons who have heretofore and without objection registered trademarks including the word "Liliputian" or some variation thereof (R. 384-411), that petitioner can have no monopoly in the word "Liliputian"; and the cases* are equally clear that

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* In *Ball* v. *Best*, 135 Fed. 434, action was brought to enjoin the defendant from using the name "Best & Co.", and likewise the words "Liliputian" and "Liliputian Outfitters". The court there found a deliberate fraud upon the plaintiff's business rights,—a finding which the courts below did not and could not make upon the record here,—and at page 436, said:

> "It is not important what definition is placed on 'Liliputian.' The name of Best & Co., with the use of that word, constituted complainant's good will. That use was arbitrary, and stands for complainant's goods. The complainant is clearly entitled to the relief prayed for as to the use of the name 'Best & Co.,' with and without prefixes. He is also entitled to the sole use of the word 'Liliputian' in connection with the name Best & Co., with and without prefixes, but only in the line of his business."

Similarly, in *Ball* v. *Broadway Bazaar*, 194 N. Y. 429, where the present petitioner's predecessor sought to enjoin a competitor which had advertised itself as the "Broadway Bazaar, Brooklyn's Best Lilliputian Store",

ownership of the mark "Liliputian Bazaar" does not confer ownership of the word "Liliputian" on the petitioner. "Liliputian" is, as the Trial Court held (R. 433), a descriptive word when standing alone, and hence, not the subject of exclusive appropriation; and the Court of last resort of the State of New York so held many years ago in adjudicating, in respect of another alleged infringement, the rights of petitioner's predecessor in this very name. *Ball* v. *Broadway Bazaar*, 194 N. Y. 429.

The courts below did not hold, as petitioner argues, that the respondent might with impunity appropriate petitioner's trademark or tradename, so long as she accompanied it by a distinguishing prefix. The courts only held, upon comparison of the marks and names in question, and in the light of the manner of their use by the respective

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the court specifically found that the name adopted by the defendant was calculated to deceive the public and had been adopted with that intent. Nevertheless, it modified the injunction granted by the lower court, saying, at page 436:

> "The judgment is, however, somewhat broader than it should be. It is quite within bounds in restraining the use of 'Best' and 'Lilliputian' and 'Bazaar' in connection with each other. It seems to be proper, also, in so far as it prohibits the use of 'Lilliputian Bazaar' either alone or in connection with any other words, and from so using any like words. * * * Although of purely fanciful origin, the word 'Lilliputian' has become a part of the English language and is used to denote persons, and possibly things, of diminutive or minute size. The word 'Bazaar' is also a part of our common speech. It is somewhat indiscriminately applied to shops, either singly or in groups, where goods are displayed for sale, to fairs or sales for the benefit of churches or charities, and to other places fitted up for the sale of goods. It is obvious that neither of these words alone can be the subject of a trade name in which any one can acquire an exclusive proprietary right. They are purely descriptive parts of our language and may be used by all. But their use together, or in combination with some other word, such as 'Best', for instance, marks the difference between what is permissible and what may be forbidden."

parties, that there was no likelihood of confusion or possibility of public deception.*

The cases which petitioner cites in Point III of its brief are all inapplicable, if this distinction is borne in mind. In each of those cases, the alleged infringer had used the plaintiff's entire trademark or tradename, attempting to avoid a charge of unfair competition by using some additional word or prefix in connection therewith.

Petitioner has not cited a single case, however, in which the use of but a single word included in a plaintiff's trademark or tradename as part of a defendant's mark or name has been held, *per se*, to constitute an infringement or unfair competition. There are, we submit, no such cases.

D.

Finally, in seeking to find a conflict between prior decisions and the instant case on which to ground its application for review by this Court, petitioner has cited, in Point IV of its brief, a number of cases which it claims should preclude respondent from using "in a competing business,

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* Substantially the same principles of law were involved in the case of *Dixi-Cola Laboratories, Inc.* v. *Coca-Cola Co.*, 117 Fed. [2d] 352, 355, wherein the Circuit Court of Appeals for the Fourth Circuit said:

> "There are many cases which hold that it is not infringement for a trader to use as part of his trade-name to designate his product a descriptive or generic word which has already been adopted by another, provided that the competing marks, taken as a whole, are clearly distinguishable."

The plaintiff in that case petitioned this Court for a writ of certiorari advancing almost the identical arguments made by the petitioner here. The answers to those arguments are, we submit the same. Certiorari was there denied in 314 U. S. 629.

'Liliputian', the dominant word in petitioner's trademark * * *". There are two obvious answers to this argument.

In the first place, as we have already indicated, each word in petitioner's mark ("Liliputian Bazaar") as used by petitioner and its predecessors throughout the years, has been given equal prominence; and, in determining either the question of infringement or of unfair competition, the mark as a whole must be considered.

As the court said in *Glenmore Distilleries* v. *National Distillers Products Corporation,* 101 Fed. (2d) 479, 480; cert. den. 307 U. S. 632:

> "It is impossible to lay down a general rule that either word in an established trademark of two words is of such importance that its use in other combinations on the same kind of goods would constitute infringement. Every case must of course be decided upon by its own facts. 'What degree of resemblance is necessary to constitute an infringement is incapable of exact definition, as applicable to all cases. All that courts of justice can do, in that regard, is to say that no trader can adopt a trademark, so resembling that of another trader, as that ordinary purchasers, buying without ordinary caution, are likely to be misled.' McLean v. Fleming, 96 U. S. 245, 251."

The second answer to petitioner's contention is that in none of the cases cited was the common word in question descriptive to any extent whatsoever, either of the goods to which the mark was affixed or the business in which the name in question was used, whereas petitioner's alleged trademark involved in the instant case, is descriptive of

the business in which both parties are engaged. The Trial Court so held* and the Circuit Court of Appeals affirmed.**

POINT III

No novel question or question of general importance or public interest is presented by the record in this case.

Point V of the petitioner's brief is a "catch-all", wherein the petitioner poses for determination by this Court six

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* District Judge Coxe (R. 430-431) said:

"During the entire period that the business had been in existence the 'Liliputian Bazaar' has been extensively advertised, and has come to signify in the minds of the buying public Best & Company. In addition, the plaintiff and its predecessors have been sedulous in their efforts to prevent the use by others of the word 'Liliputian,' and the evidence shows that these efforts have been largely successful. However, in *Ball* v. *Broadway Bazaar*, 194 N. Y. 429, it was held that the words 'Liliputian' and 'Bazaar' were common descriptive words and could not singly be appropriated, but that together they constituted a valid common law trademark."

And again, at page 433:

"I do not think that *Menendez* v. *Holt*, 128 U. S. 514, and other similar cases cited by the plaintiff have any application. In those cases, it was held that the use of a defendant's name in connection with an infringing mark is 'an aggravation and not a justification' of the infringement. Here, there is no infringement because the descriptive word 'Liliputian' standing alone, is not the subject of exclusive appropriation, *Ball* v. *Broadway Bazaar*, 194 N. Y. 429, and the defendant has a perfect right to use the word as long as it is used in a setting which does not point to Best & Company. The defendant not only adds the distinguishing word 'Shoppe' to 'Lilliputian' but also prefixes the word 'Miller's', thereby expressly negativing any suggestion of Best & Company."

** The Circuit Court of Appeals did not pass specifically upon whether or not plaintiff's mark or the word "Liliputian" therein contained was fanciful and suggestive or merely descriptive; but it did cite in a footnote (R. 447) the case of *Ball* v. *Broadway Bazaar*, 194 N. Y. 429, 436, and quoted extensively therefrom.

questions which, it asserts, have been answered differently by various intermediate courts. We have already demonstrated, in considering the specific cases cited by the petitioner as the basis for the asserted conflict, that no such conflict in principle does exist; that the cases are distinguishable on their facts, and that it was on questions of fact that the various decisions turned. That the various Circuit Courts of Appeals have properly understood and applied general legal principles in this field, settled by this Court, is apparent from the fact that at the 1947 Term of this Court eleven petitions for writs of certiorari were filed in trademark and tradename cases, directed to seven different circuits; and the writ was, in each instance, denied.*

It is noteworthy that in presenting the various questions which it claims this Court should now review, petitioner fails, in every instance, to point out how the question is raised by this record, and contents itself with stating (Br.,

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* *Ambrosia Chocolate Co.* v. *Ambrosia Cake Bakery, Inc.*, 165 F. 2d 693, cert. den. 92 L. Ed. 843;
Calif. Apparel Creators v. *Wieder of Calif., Inc.*, 162 F. 2d 893, cert. den. 92 L. Ed. 78;
National Nu-Grape Co. v. *Guest*, 164 F. 2d 874, cert. den. 92 L. Ed. 758;
Coca-Cola Co. v. *Snow Crest Beverages, Inc.*, 162 F. 2d 280, cert. den. 92 L. Ed. 74;
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Mishawaka Rubber and Woolen Mfg. Co. v. *S. S. Kresge Co.*, 75 U. S. P. Q. 2, cert. den. 92 L. Ed. 74;
Caron v. *Ollendorf*, 160 F. 2d 444, cert. den. 92 L. Ed. 21;
General Finance Loan Co. v. *General Loan Co.*, 163 F. 2d 709, cert. den. 92 L. Ed. 318;
Hanson v. *Triangle Publications, Inc.*, 163 F. 2d 74, cert. den. 332 U. S. 855;
Andrew J. McPartland, Inc. v. *Montgomery Ward & Co.*, 164 F. 2d 603, cert. den. 92 L. Ed. 759.

page 29) that "the decision below presents questions of great importance to those who expend substantial sums in advertising their tradenames or trademarks * * * in the expectation of * * * protection". This, surely, is not "an important question of federal law which has not been, but should be, settled by this Court", within the meaning of Rule XXXVIII of the General Rules of this Court.

We consider briefly, and in order, the questions suggested by the petitioner:

(a) Are tradenames used to label articles to show source entitled to the same protection as trademarks denoting products? As already indicated, the courts below in this case have made no such distinction and have indicated that the petitioner's tradename would be entitled to receive the fullest protection which could be accorded to a registered trademark if an infringement thereof had been shown; but, on the evidence, the courts found no infringement.

(b) Must actual confusion be shown where one appropriates another's tradename and engages in competition with him? So far as this case is concerned, this is a purely abstract and hypothetical question, since the Trial Court stated (R. 433) that "the test is whether the public is likely to be deceived", and the Circuit Court of Appeals held the test applied by the Trial Judge to be correct (R. 449). Clearly, the courts below did not attempt to impose upon the petitioner the burden of establishing actual confusion.

(c) There is nothing in either of the decisions below to warrant the suggestion that the courts attempted to restrict the rule laid down by this Court in *Menendez* v. *Holt*, 128 U. S. 514, to trademarks used on products. The Trial Judge (R. 433) distinguished the *Menendez* case; and the

distinction which he drew is one which this Court has itself made. *United Drug Co.* v. *Rectanus Co.*, 248 U. S. 90.

(d) In presenting the next question for review by this Court (that dealing with the so-called "free ride" doctrine), petitioner refers to the case of *LaTouraine Coffee Co., Inc.* v. *Lorraine Coffee Co., Inc.*, 157 Fed. [2d] 115; cert. den. 329 U. S. 771, and not to the case at bar. The "free ride" theory did not enter into the consideration or disposition of this case in either of the courts below. In any event, the question of a "free ride" could not arise, absent a finding that the respondent had selected a trademark or name similar to that of petitioner with knowledge of the petitioner's mark or with the intent to palm off her wares as those of the petitioner. Here, the Circuit Court of Appeals said (R. 449) "in the case at bar there is no finding that the defendant's tradename was chosen with any such intent; nor is there any evidence to justify such a finding"; and the Court went on to point out that "while not conclusive, it is not without significance in determining the likelihood of deception of the public by the use of the defendant's tradename, that no actual confusion has ever resulted during the many years since the business was started at the end of 1930".

(e) The next question posed is whether the character of proof required in trademark cases is the same as in unfair competition cases. Petitioner does not indicate how it believes this question was answered by the courts below or how it should be answered by this Court. Clearly, however, the question is no longer an open one. The essential element is substantially the same in trademark cases as in cases of unfair competition. 26 Ruling Case Law 869; *Armstrong Co.* v. *Nu-Enamel Corp.*, 305 U. S. 315, 385; *American Found-*

ries v. *Robertson*, 269 U. S. 372, 380; *Nims, Law of Unfair Competition and Trademarks* (Fourth Edition, 1947) 10, 1017.

(f) Finally, petitioner poses the question as to the prospective application of the Lanham Act, as suggested by Judge Clark's dissent in the case at bar. Neither in the dissenting opinion nor in the petition and brief for certiorari is any indication given as to how the application of the Lanham Act could possibly have changed the decision in this case. The new act merely gives statutory expression to well settled judicial construction (*LaTouraine Coffee Co., Inc.* v. *Lorraine Coffee Co., Inc.*, 157 Fed. [2d] 115; cert. den. 329 U. S. 771), and itself provides that use in commerce of a "colorable imitation" which is "likely to cause confusion or mistake" constitutes infringement. Act of July 5, 1946, c. 540, Title VI, Sec. 32(1)(a), 60 Stat. 437; U. S. C., Title 15, Sec. 1114(1)(a). Again, the likelihood of confusion, which neither of the courts below could find upon the evidence, is the test.

"The question presented", states the petitioner at page 30 of its brief, "is whether petitioner's property rights in "Liliputian Bazaar" is to receive such protection or is the name to be made worthless by permitting petitioner's competitors to use the same slogan in advertising similar wares." No such question is presented either in the petition for certiorari itself or by the record of this case, nor would such a question, if presented, be one of interest to persons other than the litigants themselves or of such general importance that this Court should undertake its review.

Respondent has never used nor claimed the right to use the name "Liliputian Bazaar" in any manner whatsoever, nor is any claim made here on behalf of the respondent or

on behalf of competitors of the petitioner for the sweeping effect which it urges may be given to the decision below. Respondent merely claims the right, granted her after full trial and careful consideration of the evidence by the courts below, to continue to use her tradename ("Miller's Lilliputian Shoppe") in the manner in which she and her predecessor in interest have used it since 1930,—a use which the courts have found has entailed not a single instance of confusion and which involves no likelihood of confusion or deception.

CONCLUSION

The petition for a writ of certiorari in this case should be denied.

Respectfully submitted,

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